

### Remarks

Claims 1, 2, 4-6, 9-12, 14, and 16-20 are pending in this application. Claims 1, 5, 10, and 18 are amended herein. The Examiner has rejected claims 1, 2, 4, 10-12, 14, and 16-20 under 35 U.S.C. § 102(e) as being unpatentable over U.S. Patent No. 6,567,892 to Horst, et al. (hereinafter “Horst”). The Examiner has rejected claims 5, 6, and 9 under 35 U.S.C. § 103(a) as being obvious over Horst in view of U. S. Patent Application Publication No. 2004/0117579 to Wu, et al. (hereinafter “Wu”). Applicants respectfully request that the above amendments be entered, and Applicants respectfully traverse the Examiner’s rejections. Applicants thank the Examiner for his careful consideration of this application and the references that Applicants have submitted.

**A. Remarks Regarding Rejection of Claims 1, 10, and 18 under 35 U.S.C. § 102(e)**

A prior art patent, publication, or event is for the same “invention,” as that word is used in §102, and therefore anticipating, if the prior art patent, publication or event discloses each and every limitation found in the claims, either expressly or inherently. *Rockwell Intern. Corp. v. Us.*, 147 F.3d 1358, 1363 (Fed. Cir. 1998); *Electro Med. Sys. S.A. v. Cooper Life Sciences*, 34 F.3d 1048, 1052 (Fed. Cir. 1994). Each claim limitation must be found in a single prior art reference; references cannot be combined under §102. *Apple Computer, Inc. v. Articulate Systems, Inc.*, 234 F.3d 14, 20 (Fed. Cir. 2000). Omission of any claimed element, no matter how insubstantial, is grounds for traversing a rejection based on §102. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542 (Fed. Cir. 1983).

Horst does not disclose all of the limitations of amended independent claims 1, 10, and 18. *Inter alia*, Horst does not disclose the limitation of a predetermined threshold value

for the count of commands, wherein the predetermined threshold value is less than the maximum number of commands that may be recorded, as required in claims 1, 10, and 18. The Advisory Action contends that Horst teaches a predetermined threshold value at column 7, lines 35-67, equating the predetermined threshold with the maximum device driver queue depth (256 entries). Advisory Action at page 2. Horst discloses that reaching the maximum device driver queue depth would indicate that the host system has run out of commands. Horst col. 7, lines 60-62. Whether the host system has run out of commands would be independent of any sort of predetermined threshold value that is less than the maximum number of commands that may be recorded. Therefore, Horst does not teach the limitations of a predetermined threshold value for the count of commands, wherein the predetermined threshold value is less than the maximum number of commands that may be recorded, as required by independent claims 1, 10, and 18.

For at least these reasons, Horst does not anticipate independent claims 1, 10, and 18, and Applicants respectfully request that the rejection of these claims be withdrawn.

**B. Remarks Regarding Rejection of Claim 5 under 35 U.S.C. § 103 (a)**

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

The combination of Horst and Wu fails to teach or suggest all the claim limitations of amended independent claim 5. For example, the combination fails to teach or suggest a predetermined threshold for the number of write commands, wherein the predetermined

threshold is less than the maximum number of commands that may be recorded. As previously discussed, Horst fails to teach this limitation (*see supra* Section A). Wu also fails to teach or suggest this limitation. Wu simply teaches “systems and methods for implementing shared memory regions in a distributed shared memory system.” At best, Wu teaches data word counts, which are not the same as the command counts recited in independent claim 5. Wu utterly fails to teach a predetermined threshold number of commands, wherein the predetermined threshold is less than the maximum number of write commands that may be recorded. Therefore, the combination of Horst and Wu fails to teach all of the claim limitations of independent claim 5.

**C. Remarks Regarding Rejections of Dependent Claims 2, 4, 6, 9, 11-12, 14, 16-17, and 19-20**

The rejections of dependent claims 2, 4, 6, 9, 11-12, 14, 16-17, and 19-20 will not be discussed individually herein, as each of these claims depends, either directly or indirectly, from an otherwise allowable base claim.

**III. No Waiver**

All of Applicants’ arguments are without prejudice or disclaimer. By not responding to additional statements made by the Examiner, Applicants do not acquiesce to the Examiner’s additional statements, such as, for example, any statements relating to what would be obvious to a person of ordinary skill in the art.

**Conclusion**

Applicants respectfully submit that pending claims 1, 2, 4-6, 9-12, 14, and 16-20 of the present invention are allowable. Applicants respectfully request that the rejection of these claims be withdrawn and that these claims be passed to issuance.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Shannon Powers", is written over a horizontal line.

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